

TRANSMITTAL OF APPEAL BRIEF (Large Entity)

Docket No.
YOR919990097US1

In Re Application Of: Schrott et al.

Application No.

09/306,511

Filing Date

May 7, 1999

Examiner

Vernal Brown

Customer No.

48150

Group Art Unit

2635

Confirmation No.

3541

Invention: **INTELLIGENT ANTITHEFT METHOD AND SYSTEM COMBINING MAGNETIC TAGS AND CARDS**

COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on

The fee for filing this Appeal Brief is: \$500.00

- ☐ A check in the amount of the fee is enclosed.
- ☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
- ☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. 50-0510
- ☐ Payment by credit card. Form PTO-2038 is attached.

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Dated: March 4, 2005

Signature

Frederick E. Cooperrider

Registration No. 36,769

Customer No. 48150

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

(Date)

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

CC:



Appellant's Brief on Appeal
S/N: 09/306,510

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

Schrott et al.

Serial No.: 09/306,510

Group Art Unit: 2635

Filed: May 7, 1999

Examiner: Vernal Brown

For: INTELLIGENT ANTITHEFT METHOD AND SYSTEM COMBINING
MAGNETIC TAGS AND CARDS

Commissioner of Patents
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL

Sir:

Appellants respectfully appeal the rejection of claims 1-2, 4-6, 8-16, and 18-29 in the Office Action dated October 10, 2004. A Notice of Appeal was timely filed on January 4, 2005.

03/08/2005 SZENDIE1 00000029 500510 09306510
01 FC:1402 500.00 DA

I. REAL PARTY IN INTEREST

The real party in interest is International Business Machines Corporation, assignee of 100% interest of the above-referenced patent application.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to Appellants, Appellants' legal representative, or Assignee, which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Docket: YO999-097 (YOR.072)

III. STATUS OF CLAIMS

Claims 1-2, 4-6, 8-16, and 18-29 are all of the claims presently pending in the application. In the Advisory Action dated December 22, 2005, the Examiner indicated that the After-Final Amendment filed on December 7, 2004, would be entered into the record upon filing an Appeal. The claims attached hereto reflect the claims in the After-Final Amendment filed on December 7, 2004.

In this Final Office Action dated October 4, 2004, the Examiner maintained and made final the previous rejection. More specifically, claims 1, 4-7, 10, 15, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme (U.S. Patent No. 5,886,634), further in view of Yeadon (U.S. Patent No. 6,393,339).

Claims 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 4,881,061 to Chambers.

Claims 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 5,883,582 to Bowers et al.

Claims 2 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, further in view of U.S. Patent No. 5,984,388 to Bacon.

Claims 8 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of U.S. Patent No. 6,297,727 to Nelson.

Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon and Nelson, and further in view of US Patent 5,745,036 to Clare.

Claims 9, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Muhme, further in view of Yeadon, and further in view of US Patent 4,471,343 to Lemelson.

IV. STATUS OF AMENDMENTS

An Amendment Under 37 CFR §1.116 was filed on December 7, 2004. In the Advisory Action dated December 22, 2004, the Examiner indicated that the arguments in the After-Final Amendment were not persuasive, that the rejection currently of record was maintained, but that the Amendment would be entered into the record upon Appeal. The claims in the attached Appendix reflect the version contained in this After-Final Amendment.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants' invention, as disclosed and shown in Figure 1 and defined in independent claim 1, is directed to a system 100 for preventing theft of an object (page 4 at lines 15-18). An electronic article surveillance (EAS) device 10 is operatively attached to an object 20 (page 5 at lines 4-16). A security path 11, 30, 40, 50 detects the EAS device 10, and the security path includes at least one security gate 11 (page 5 at lines 17-18).

A reader 12 is operatively coupled to the security path and associated with one of the at least one security gate 11 (page 6 at lines 3-4). A smart card 21, for being read by the reader 12, contains an identification profile of an authorized user of the object (page 6 at line 5).

A computer 30 is attached to the reader and disables, after the smart card is read by the reader, a security function of the security path at the security gate if a person presenting the smart card at the reader is determined as being authorized to remove the object (page 6 at line 6 through page 7 at line 7).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellants present the following issues for review by the Board of Patent Appeals and Interferences for the obviousness rejections based on US PATENT 5,886,634 to Muhme.

Issue #1: The rejection currently of record fails to meet the initial burden of a *prima facie* rejection for claim 21 because it fails to address the plain meaning of the claim language, as

would be interpreted by one of ordinary skill in the art, and more specifically, a two-step process in which the security function is first activated and then deactivated;

Issue #2: The rejection currently of record fails to meet the initial burden of a *prima facie* rejection because it fails to heed the plain meaning of the claim language of various dependent claims, as interpreted by one of ordinary skill in the art; and

Issue #3: The rejection currently of record improperly uses hindsight by ignoring that the engineering design and the statements within the primary reference Muhme that clearly teach against the modifications that would be needed to satisfy the invention by various independent and dependent claims and/or the Examiner's rationale for modifying the primary reference Muhme.

VII. ARGUMENTS

ISSUE #1: The Plain Meaning of the Independent Claim 21 Language

A. The Examiner's Position

On page 10 of the Final Office Action dated October 4, 2004, the Examiner provides a rejection for claim 21. However, this rejection fails to address the plain meaning of the claim language: "...wherein upon passage through said path without first having established that said person is authorized to remove said object, said EAS device triggers the path to activate said alarm and subsequently, when said smart card is read by said reader and said person is determined as being authorized to remove said object, said security function at said security gate is disabled by said computer"

It is noted, preliminarily, that the rejection of record proceeds to either replace the second tag 22, used for authenticating that the person is authorized to remove the object with the first tag 20, with a smart card and, presumably, also adds a smart card reader to accommodate the smart card, or, to simply add the missing smart card as an additional security system to Muhme, an issue discussed elsewhere.

B. Appellants' Position on the Plain Meaning of the Claim 21 Language

1. The Examiner's position is clearly flawed as a matter of law.

Appellants submit that case law clearly requires that the prior art evaluation apply the plain meaning of the claim language, as clearly stated at MPEP §2111:

"...the "PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definition or otherwise that may be afforded by the written description contained in the applicant's specification."

Appellant submits that the Examiner's position and reasoning simply fails to do so for the limitation recited above for independent claim 21.

Appellants submit that a two-step process is well defined in independent claim 21, as well as dependent claims 28 and 29. Although the Examiner attempts to modify Muhme with Lemelson for claims 28 and 29, Appellants submit that such modification would change the principle of operation of the primary reference Muhme, as shown in the flowchart of Figure 4.

That is, Appellants submit that such modification is prohibited by MPEP §2143.01: *"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claim prima facie obvious."*

Along this same line, Appellants further submit that, because the principle of operation in Muhme would inherently have to be modified from that shown in Figure 4, this reference Muhme cannot even be used as the primary reference in a prior art evaluation of claims 21, 28, and 29 without violating this guideline in MPEP §2143.01.

This two-step technique of non-limiting embodiments of the present invention provides advantages not described in the prior art currently of record. For example, as described at lines 8-20 of page 8, a camera can be turned on as soon as the antitheft device 10 is detected, in order to record the event, whether authorized or non-authorized, thereby allowing both authorized removals and non-authorized events/attempts to be separately counted.

Moreover, in the present invention, the disablement feature allows the smart card to serve as a "reset" function for the security function, thereby allowing the second step of resetting the security function to be recorded, as part of the record for events that are authorized. Also, as briefly mentioned in the discussion beginning at line 5 on page 2, the reset feature permits an authorized person located near the security gate to be able to clear an alarm using the smart card to disable the activated alarm.

2. The Examiner's position is flawed as a matter of fact.

The technique in Muhme clearly does not have this two-step technique in which the alarm (e.g., security function) is *first turned on* upon detecting the EAS tag and *then disabled* upon receiving an input from a smart card of an authorized user.

That is, as clearly shown in the flowchart in Figure 4, upon receiving an interrogation transmission from the EAS tag 10 in step 206, a timer is initiated in step 208 that defines a time interval during which interrogation transmissions from any and all associated tags need to be received. At the end of the timer period, in step 256, it is determined whether to activate the security function.

Thus, in Muhme, there is no two-step process of first activating a security function (e.g., in response to receiving a transmission of the EAS tag 10) and then deactivating the security function in response to having received a transmission of the associated tag 20, as clearly required by the plain meaning of the language of the independent claims. Moreover, the deactivation in step 274 of Muhme Figure 4 is not associated with whether the second tag 20 is received and confirmed as authenticating the first tag's transmission, as would be clearly required by the plain meaning of the claim language.

Therefore, Appellants submit that, even if the primary reference Muhme were to be modified to incorporate a smart card in place of the second tag 20, the basic technique shown in Figure 4 demonstrates that Muhme fails to satisfy the plain meaning of the claim language of

independent claim 21 and dependent claims 28 and 29, and that these claims are clearly allowable over Muhme because of this basic deficiency.

ISSUE #2: The Plain Meaning of Various Dependent Claims

Relative to the rejection for claim 8, Appellants submit that the Examiner ignores the plain meaning of the claim language, even assuming *arguendo* that modification of Muhme were considered to be appropriate. The claim language clearly defines the video as being activated "... upon interrogating said EAS device." In Muhme, this would require that all events cause the video to be activated, since the device 20 initiates the entire sequence, as clearly shown in Figure 4. In contrast, line 23 of column 10 of Nelson clearly teaches obtaining a video record only for events without authorization. Therefore, Appellants submit that, even if Nelson were to be combined with Muhme, the claimed result would not be achieved, since neither Muhme nor Nelson would teach or suggest activating a response immediately upon interrogating the EAS device.

Relative to the rejection for claim 24, Appellants submit that in the rejection on pages 11 and 12 of the Office Action, the Examiner fails to address the plain meaning of the claim language that the alarm is turned off when the smart card contains the identification profile of the authorized user.

Relative to the rejection for claims 26-27, Appellants respectfully submit that one of ordinary skill in the art would consider the Examiner's characterization on page 13 ("... *it is the conventional practice to video taped [sic] (using a video camera) all egress and ingress activities at a security gate as is evidenced by Clare (col. 7 lines 40-46) and the taping of all the activities at the security gate includes capturing a video image each time the alarm is turned off and when the smart card includes the identification profile of the authorized user.*") of the Office Action is entirely different from the plain meaning of the claim language.

That is, Appellants submit that the Examiner simply ignores the plain meaning of the language of these two claims.

Relative to the rejection for claims 28-29, Appellants submit that the Examiner simply ignores the plain meaning of the claim language that the alarm is first turned on and then, upon determining that the user is authorized by reading the smart card, then turned off.

Because the plain meaning of the claim language is ignored, Appellants submit that the initial burden of a *prima facie* rejection has not been met for these claims.

ISSUE #3: Improper Hindsight

A. The Examiner's Position on the Hindsight Issues

Beginning at the bottom of page 3 of the Office Action dated October 4, 2004, relative to the rejection for claim 1, the Examiner states that Muhme is "... silent on teaching a smart card containing an identification profile of an authorized user" On page 5 the Examiner has similar wording relative to independent claim 15, and on page 10 for independent claim 21.

Thus, it appears that the Examiner considers that Muhme "... is silent ..." on modifying its configuration as would be necessary to satisfy the plain meaning of the independent claims by somehow incorporating a smart card, either by replacing the EAS second tag 22 with a smart card and incorporating a card reader in addition to the wireless system originally used to detect the EAS tags 20,22, or, possibly, by simply adding a second security system to that described in Muhme (e.g., a second security system having a smart card).

It also appears that the Examiner considers that Muhme "... is silent ..." on modifying its configuration to modify the EAS second tag 22 to incorporate the identification profile of an authorized user.

Therefore, it is concluded that the Examiner concedes that Muhme itself fails to teach or suggest making a modification to somehow incorporate a smart card having an identification profile of an authorized user.

Nevertheless, the Examiner adopts a position that changes would be obvious because, according to the Examiner, these changes would "... provide a more secure system."

Therefore, it appears that the Examiner considers that somehow incorporating a smart card having an authorized user identification profile would somehow enhance security for the system in Muhme.

It is noted that the Examiner fails to explain how such security enhancement is provided by such changes. Nor does the Examiner explain how the prior art itself makes such suggestion, particularly since the Examiner is understood as conceding that Muhme itself fails to make any suggestion for such change. It is further noted that the Examiner does not clearly explain how the missing smart card is to be incorporated.

Relative to claim 8, the Examiner states in the first paragraph on page 7 of the Office Action that Muhme "... is silent..." on teaching a video, with the video being activated upon interrogating the second tag 22. In the next paragraph, the Examiner alleges that one of ordinary skill would be motivated to modify Muhme to incorporate a video receiver as taught in Nelson "... in order to have evidence of an unauthorized person transporting an object through a security gate."

Therefore, it appears that the Examiner concedes that Muhme itself fails to teach or suggest incorporation of a video system but that one of ordinary skill in the art would recognize that Muhme was deficient in obtaining evidence of an unauthorized person transporting an object through a gate and would, therefore, be motivated to search for references that provide such evidence.

Relative to claims 12-14, in the rejections for these claims on page 9, the Examiner states that Muhme, further in view of Yeadon, "... teaches a contact-less card but is silent on using a direct contact smart card", and that Muhme "... is silent on teaching a smart card comprising a magnetic strip." The Examiner is understood as further alleging that one of ordinary skill in the art would have been motivated to further modify Muhme/Yeadon to use various different types of smart cards, as described in these claims, basically, because such smart cards were known in the art.

Therefore, it appears that the Examiner concedes that Muhme itself fails to teach or suggest modifying its configuration to incorporate a smart card of the types described in these claims but that motivation exists simply because these types were known in the art.

B. Appellants' Position on the Hindsight Issues

First, the Examiner's position is flawed as a matter of law.

Appellants respectfully submit that Muhme cannot be used as the primary reference in a proper obviousness evaluation because its principle of operation would have to be improperly modified and because it clearly teaches against a number of required changes, both of which would be improper under MPEP §2143.01.

First, it cannot be reasonably disputed that Muhme clearly teaches (e.g., at lines 1-7 of column 2 that there are advantages to be gained by using wireless transmission for the two tags 20, 22, as opposed to using the card-based systems discussed at lines 15-21 of column 1, including convenience (lines 4-5 of column 2) and heightened security (lines 6-7 of column 2). Therefore, the Examiner cannot simply ignore that Muhme itself teaches against a modification to incorporate a card-based system and or modification to replace the second tag 22.

Second, such modification would clearly change the principle of operation shown in Figure 4 and discussed throughout the reference.

Moreover, Muhme also clearly teaches against the two-step process of first activating a security function (e.g., an alarm) upon detection of the first tag 20 and then deactivating the alarm upon detection of the second tag 22. As pointed out in the previous section, Muhme clearly teaches a single-step process in activating the security function. There is no first step of activating the alarm, which first step is followed by a second step to disable the alarm upon presentation of the second tag 22, which two-step process would be required to satisfy the plain meaning of the claim language. The Examiner is not entitled to simply change the principle of operation in Muhme, using the claimed invention as a roadmap.

That is, the flowchart in Figure 4 clearly shows the principle of operation of Muhme in which the decision for activating a security function depends entirely upon whether the second tag 22 is detected within a specific timing interval (step 216) after having detected the first tag 20. If the security function were to be turned on immediately upon detecting the first tag 20 (e.g., at step 206), the principle of operation of this flowchart is impermissibly entirely changed.

Muhme also clearly teaches against immediately activating an alarm at lines 33-36 of column 3, wherein an immediate alarm would defeat the purpose of entrapping a person attempting an unauthorized exit.

Appellants submit that the rejections of record merely reflect the well-recognized phenomena that inventions are, typically, new combinations of existing elements, for which it always possible to improperly use the defined invention as the roadmap to piece together the elements, justifying the combination as obvious because it provides the benefit of having made the combination.

As pointed out in MPEP §2143.01: *“The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”* (emphasis in MPEP itself)

Appellants submit that this deficiency shows up clearly in the motivation currently of record to modify Muhme for even the independent claims, wherein it would be necessary to incorporate a smart card into the primary reference.

The Examiner mysteriously and summarily alleges that such modification would “... provide a more secure system.”

Nowhere in the rejection does the Examiner attempt to provide a reasonable explanation as to why one of ordinary skill in the art would understand that such modification is, in fact, more secure. Nor does the Examiner explain exactly how the smart card is obvious to incorporate. Both Appellants and the Board of Appeals are left to speculate on the Examiner's intended rejection.

Given this inherent confusion, Appellants submit that the rejection currently of record fails to meet the initial burden of a *prima facie* rejection.

Perhaps the Examiner's intended meaning, not explicitly stated on the record, is that by merely adding additional security systems, additional security is inherently obtained. That is, the wording of the rejection currently of record might be construed to mean that the primary reference Muhme is not modified in any manner whatsoever, but rather, the rejection is actually intended that Muhme's security system is merely augmented to additionally incorporate a smart card reader system, such as described in secondary reference Yeadon, in addition to the system described in Muhme.

If such interpretation is indeed the Examiner's intent in this rejection, Appellants respond that Muhme specifically and very clearly teaches against such combination by describing very clearly at lines 15-21 of column 1 the disadvantages of using cards and, at lines 4-7 of column 2 the specific benefits (e.g., convenience and heightened security) if a wireless system, rather than one based on cards.

Thus, Appellants submit that, if the Examiner intends the prior art evaluation to consist of simply adding a card reader to the primary reference Muhme, then the clear contrary intent at the above-recited lines of the primary reference would be defeated by such simple addition. Therefore, Appellants submit that a prior art evaluation based on simply adding a second security system to Muhme would fail as a *prima facie* rejection, because of MPEP §2143.01: "*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.*"

Moreover, presuming a simple addition of a second security system, the Examiner is left with the dilemma of two disparate systems that are not properly interfaced in the manner described in the independent claims.

Appellants further submit that, if the Examiner does intend to simply "kludge together" two disparate inventions to arrive at the claimed invention, when the primary reference itself

explains the disadvantage of the card system of the secondary reference, this is clear evidence of impermissible hindsight.

Appellants further submit that, because of the significant costs of having two independent systems rather than one, one of ordinary skill in the art would not be motivated to simply add a second security system to Muhme.

If, on the other hand, the Examiner's intent in the rejection is the modification of Muhme, then the same lines recited above clearly teach against this modification and the same recitation from MPEP §2143.01 would apply.

Moreover, in order to meet the initial burden of a *prima facie* rejection, the Examiner would have to explain why one of ordinary skill in the art, given the primary reference Muhme as the starting point, would even be motivated to search for improvement of Muhme when Muhme already describes itself (e.g., at lines 6-7 of column 2) as providing heightened security over a system with cards.

Thus, Appellants submit that the primary reference itself contradicts the Examiner's motivation for modification or combination with another reference to incorporate a smart card system, either by modifying the existing security system taught in Muhme or by adding a second security system.

Relative to the rejection for claim 8, it is noted that the Examiner fails to explain why one of ordinary skill in the art, given Muhme, would be motivated to consult another reference for purpose of having "... evidence of an unauthorized person transporting an object through a security gate" when Muhme clearly teaches at lines 33-36 of column 3 that an unauthorized person attempting to remove an object be detained in the revolving door.

That is, entrapping an unauthorized person in the actual process of removing an object is perhaps as good as, if not even better, evidence than obtaining a video image. Therefore, given that Muhme already teaches a different method of obtaining evidence, it is submitted that one of ordinary skill in the art would have no reason to install a video system for this purpose, absent impermissible hindsight.

Moreover, relative to the plain meaning of the language in claim 8, the video receiver is described as being activated upon interrogating the EAS device. In Muhme, the flowchart in Figure 4 clearly shows that the principle of operation therein would not support this plain meaning. Muhme, in steps 208-216, clearly requires that a timer be set and timeout before any security function is activated. This time delay inherently precludes that a video receiver be incorporated in Muhme in a manner that satisfies the plain meaning of the claim language without changing the principle of operation of Muhme.

Relative to the rejection for claims 26-27, relative to the Examiner's motivation to modify Muhme/Yeadon/Nelson in accordance with Clare, Appellants submit that the rationale is nothing but a statement that the video surveillance is known and, therefore, obvious to incorporate. Appellants submit that such conclusory rationale violates the guidelines at 2143.01: *"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."* (emphasis in MPEP itself); and *"A statement that modifications of the prior art to meet the claimed invention would have been "... 'well within the ordinary skill of the art at the time the claimed invention was made'" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references."* (emphasis in MPEP itself)

Secondly, the Examiner's position is flawed as a matter of fact.

Appellants respectfully submit that Muhme is not "silent" on teaching a smart card, as characterized by the Examiner, but rather clearly teaches against such use.

That is, the description at lines 15-21 of column 1 clearly demonstrates that this reference considers the two-tag method taught therein as superior to using a smart card reader of the prior art. That inventor's rationale is clearly described at lines 4-7 of column 2: *"This provides*

convenience to the persons using the security system, and heightens security since tags may be embedded or concealed within items.”

Moreover, relative to the Examiner's motivation to modify Muhme to incorporate a smart card (e.g., “... *in order to provide a more secure system*”), Appellants submit that Muhme clearly teaches against the Examiner's allegation of enhanced security by clearly stating at lines 6-7 of column 2 that its method of using wireless transmissions to read tags (e.g., compared to the prior art technique of using a smart card, as described at lines 15-21 of column 1) “... heightens security since tags may be embedded or concealed within items.”

Thus, Appellants submit that Muhme itself clearly contradicts the Examiner's position and allegations in the rejection currently of record.

It is noted that the Examiner makes no attempt whatsoever to justify the position that a smart card will somehow “... provide a more secure system.”

Moreover, Appellants submit that one of ordinary skill in the art would not be motivated to modify the two-tag reader technique in Muhme, since such modification would clearly require a second, additional reader, thereby increasing system cost significantly, in addition to defeating the convenience so clearly at lines 4-5 of column 2.

Relative to the rejection for claims 28 and 29 on page 13 of the Office Action, the Examiner alleges that Muhme, in view of Yeadon, “... is silent on teaching the turning off of the alarm by a person authorized to remove an object.”

Appellants respectfully submit that Muhme is not silent about turning off an alarm set off by a person authorized to remove an object by reason that such alarm scenario is simply not possible in Muhme, as clearly shown in the flowchart of Figure 4. Moreover, Muhme clearly already has a RESET feature shown in step 274 in Figure 4, and is not described at lines 11-15 of column 8 as being dependent upon having the second tag 20 presented to the system after the alarm has occurred.

Appellants' Brief on Appeal
S/N: 09/306,510

It is further submitted that the rationale for modifying Muhme/Yeadon on page 14 of the Office Action in accordance with Lemelson is improper, since it is merely a re-statement of the feature conceded as missing.

IX. CONCLUSION

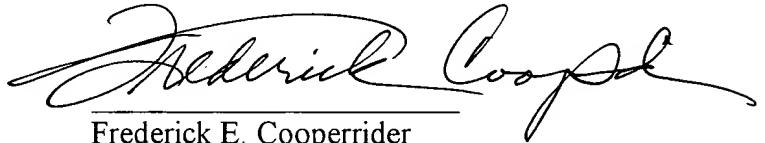
In view of the foregoing, Appellants submit that claims 1, 2, 4-6, 8-16, and 18-29 are clearly patentably distinct from the prior art of record and in condition for allowance. Thus, the Board is respectfully requested to remove the rejections of these claims.

Please charge any deficiencies and/or credit any overpayments necessary to enter this paper to Assignees's Deposit Account number 50-0510.

Dated: 3/4/05

McGinn & Gibb, P.C.
8231 Old Courthouse Road, Suite 200
Vienna, VA 22182-3817
(703) 761-4100
Customer Number: 21254

Respectfully submitted,



Frederick E. Cooperrider
Reg. No. 36,769

APPENDIX

Claims, as reflected by the Amendment Under 37 CFR §1.116 filed on December 7, 2004, which the Examiner indicated in the Advisory Action dated December 22, 2004, would be entered into the record for this Appeal:

1. (Previously presented) A system for preventing theft of an object, said system comprising:
 - an electronic article surveillance (EAS) device operatively attached to an object;
 - a security path for detection of said EAS device, said security path including at least one security gate;
 - a reader operatively coupled to said security path and associated with one of said at least one security gate;
 - a smart card for being read by said reader, said smart card containing an identification profile of an authorized user of said object; and
 - a computer attached to said reader, said computer disabling a security function of said security path at said security gate if a person presenting said smart card at said reader is determined as being authorized to remove said object after having said smart card read by said reader.
2. (Original) The system according to claim 1, wherein said EAS device comprises an acousto-magnetic tag.

3. (Canceled)

4. (Original) The system according to claim 1, wherein said EAS device comprises a radio frequency (RF) tag.

5. (Previously presented) The system according to claim 1, wherein said gate is for interrogating said EAS device, said gate including said reader being one of built integrally thereto and in a proximity thereof.

6. (Previously Presented) The system according to claim 1, wherein said computer contains a database including information regarding said authorized user of said object.

7. (Canceled)

8. (Previously presented) The system according to claim 1, further comprising a video receiver operatively coupled to said path, said path activating said video receiver upon interrogating said EAS device.

9. (Previously presented) The system according to claim 28, wherein either said alarm is turned off or an authorized user is allowed free passage through said path, when said smart card is presented to said reader.
10. (Original) The system according to claim 1, further comprising a storage device, coupled to said reader, containing information on personnel authorized to enter through or exit through said path with said object.
11. (Original) The system according to claim 6, wherein said computer logs a time and user identity related to passage through said path.
12. (Original) The system according to claim 1, wherein said smart card comprises a direct contact smart card.
13. (Original) The system according to claim 1, wherein said smart card comprises a contact-less smart card.
14. (Original) The system according to claim 1, wherein said smart card comprises a magnetic strip containing a code.

15. (Previously presented) A method for preventing theft of an object, said method comprising:

operatively attaching an electronic article surveillance (EAS) device to an object;
detecting said EAS device as said object traverses a security path;
operatively coupling a reader to said security path, said reader associated with a security gate in said security path;
reading, by said reader, a smart card being presented to said reader as said object traverses said security path, said smart card containing an identification profile of an authorized user of said object; and
attaching a computer to said reader, said computer disabling a security function of said security path at said security gate if said smart card is determined as being associated with a person authorized to remove said object.

16. (Original) The method according to claim 15, wherein said EAS device comprises an acousto-magnetic tag.

17. (Canceled)

18. (Original) The method according to claim 15, wherein said EAS device comprises a radio frequency (RF) tag.

19. (Previously presented) The method according to claim 15, wherein said security gate is for interrogating said EAS device, said gate including said reader being one of built integrally thereto and in a proximity thereof.

20. (Previously presented) The method according to claim 15, further comprising:

providing said computer with a database including information regarding said authorized user of said object.

21. (Previously presented) A system for preventing theft of an object, said system comprising:

an electronic article surveillance (EAS) device operatively attached to an object;

a security path for detection of said EAS device;

a reader operatively coupled to said security path, said reader located at or near a security gate of said security path;

a smart card for being read by said reader, said smart card containing an identification profile of an authorized user of said object;

a computer attached to said reader, said computer disabling a security function at said security gate if said smart card is determined to be that of a person authorized to remove said object; and

operatively coupling an alarm to said security path,

wherein upon passage through said path without first having established that said person is authorized to remove said object, said EAS device triggers the path to activate said alarm and subsequently, when said smart card is read by said reader and said person is determined as being authorized to remove said object, said security function at said security gate is disabled by said computer, and

wherein said EAS device continuously outputs a signal to said security path.

22. (Previously Presented) The system according to claim 21 wherein the identification profile is obtained independently of said signal.

23. (Previously presented) The system according to claim 21 wherein said computer opens said security gate when said smart card is determined to include the identification profile of the authorized user of said object.

24. (Previously presented) The system according to claim 21, wherein said computer turns off said alarm when said smart card includes the identification profile of the authorized user of said object.

25. (Previously presented) The system according to claim 28, further comprising:
a video camera,

wherein a video image is captured each time said alarm is actuated.

26. (Previously presented) The system according to claim 28, further comprising:

a video camera,

wherein a video image is captured each time said alarm is turned off.

27. (Previously presented) The system according to claim 1, further comprising:

a video camera,

wherein a video image is captured when said smart card includes the identification profile of the authorized user of said object.

28. (Previously presented) The system according to claim 1, further comprising:

an alarm operatively coupled to said security path,

wherein upon passage through said path without first having established that said person is authorized to remove said object, said EAS device triggers the path to activate said alarm and subsequently, when said smart card is read by said reader and said person is determined as being authorized to remove said object, said alarm is turned off.

29. (Previously presented) The method according to claim 15, further comprising:

operatively coupling an alarm to said security path;

Appellants' Brief on Appeal
S/N: 09/306,510

activating said alarm upon passage through said path without first having established that said person is authorized to remove said object; and

turning off said alarm when said smart card is read by said reader and said person is determined as being authorized to remove said object.